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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/776,493

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Peter V. Boesch

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SUITE 3200
DES MOINES, IA 50309-2721

EXAMINER

RAMAKRISHNAIAH, MELUR

ART UNIT

PAPER NUMBER

2614

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/776,493

Applicant(s)

BOESEN, PETER V.

Examiner

Melur Ramakrishnaiah

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 5-18-05 10-26-05 12-21-05

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-36 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-50 of U.S. Patent No. 6,542,721.

Although the conflicting claims are not identical, they are not patentably distinct from each other because, for example claim 1 of the current application is an obvious variation of claim 1 of U.S. Patent No. 6,542,721.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 35-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For example claim 35 recites: the personal

communication of device of claim 31 wherein third body is hinged to third body. The phrase "third body is hinged to third body" does not make any sense. Similar situation exists in claim 36 also.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mack, II et al. (US PAT: 6,510,325, filed 9-27-1999, hereinafter Mack) in view of Shimamura (US PAT: 7,176,961, filed 12-27-2002).

Regarding claim 1, Mack discloses a handheld personal communication device comprising: a first body having a display (20, fig. 3B), a second body having a plurality of manual inputs (2, fig. 3B), the first body adapted for attachment to the second body, the personal communication device having an open position wherein the display (20, fig. 3B) of the first body and manual inputs of the second body are accessibly exposed to the face of the user (as shown in fig. 3B), the personal communications device having a closed position wherein the display of the first body is at least partially protected by the second body and manual inputs of the second body are accessibly exposed to the face the user (as shown in fig. 1A; col. 6, line 34 – 60; col. 4 lines 13-48).

Mack differs from claim 1 in that he does not teach: a video camera operatively connected to the second body such that in closed position the video camera faces the user and in the open position the video camera faces away from the user.

However, Shimamura discloses portable electronic device and portable cellular telephone which teaches the following: a video camera operatively connected to the second body such that in closed position the video camera faces the user (as shown in fig. 1) and in the open position the video camera faces away from the user (as shown in fig. 2; col. 6 lines 24 – 64).

Thus, it would have been obvious to one of ordinary skill to modify Mack's system to provide for the following: a video camera operatively connected to the second body such that in closed position the video camera faces the user and in the open position the video camera faces away from the user as this arrangement would facilitate to provide camera arrangement suitable for user applications as taught by Shimamura.

Regarding claim 2, Mack teaches the following: display includes a sub region (6, fig. 1) viewable user in closed position.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mack in view of Shimamura as applied to claim 1 above, and further in view of Yachi (JP406253296A) and Chihara et al. (US PAT: 6,714,233, filed 5-20-2001, hereinafter Chihara).

The combination differs from claim 3 in that it does not specifically teach: first body is removably attached to the second body and each of the first and second body includes closes range transceiver.

However, Yachi discloses video telephone set which teaches: first body (11, fig. 1) is removably attached to the second body (reads on main body as shown in fig. 1; see abstract) and further Chihara teaches: first body (12, fig. 1) and the second body (11, fig. 1) includes a close range transceiver (fig. 2; col. 7, line 3 – col. 8, line 50).

Thus, it would have been obvious to one of ordinary skill to modify the combination to provide for the following: first body is removably attached to the second body as this arrangement would provide for flexibility to use of equipment to meet user needs as taught by Yachi; and each of the first and second body includes closes range transceiver as this arrangement would facilitate to provide wireless communication between devices as taught by Chihara, thus providing user to move around while communicating as taught by Chihara.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mack in view of Shimamura as applied to claim 1 above, and further in view of Kang (US PAT: 7,133,691, filed 6-4-2002).

The combination differs from claim 4 in that he does not specifically teach: display is adapted to operate as a viewfinder associated with the video camera when in an open position.

However, Kang discloses portable telephone with camera which teaches the following: display is adapted to operate as a viewfinder associated with the video camera when in an open position (figs. 8-9, col. 6 lines 39-47).

Thus, it would have been obvious to one of ordinary skill to modify the combination to provide for the following: display is adapted to operate as a viewfinder associated with the video camera when in an open position as this arrangement would facilitate the user to view the camera image before proceeding to take the picture as taught by Kang, thus making sure they get the picture they want.

9. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mack in view of Shimamura and Futami (JP09-187060).

Regarding claim 5, Mack discloses a system for personal voice and video communications, comprising: a handheld personal communication device comprising a first body having a display (20, fig. 3B) and a second body having a plurality of inputs (2, fig. 3B), the first body adapted for attachment to the second body, the personal communications device having an open position wherein the display (20, fig. 3B) of the first body and manual inputs of the second body (2, fig. 3B) are accessibly exposed to face a user (see fig. 3B), the personal communication device having a closed position wherein the display of the first body is at least partially protected by the second body and manual inputs of the second body are accessibly exposed to face a user (see fig. 3A, col. 6 lines 30-60).

Mack differs from claim 5 in that he does not teach: a video camera operatively connected to the second body such that in closed position the video camera faces the user and in the open position the video camera faces away from the use; and handheld communication device having a voice transceiver and close range transceiver, an

earpiece comprising a bone conduction sensor operatively connected to a second close range transceiver for communication with the handheld personal communication device.

However, Shimamura discloses portable electronic device and portable cellular telephone which teaches the following: a video camera operatively connected to the second body such that in closed position the video camera faces the user (as shown in fig. 1) and in the open position the video camera faces away from the user (as shown in fig. 2; col. 6 lines 24 – 64); and Futami discloses portable telephone set with wireless earphone which teaches the following: handheld communication device having a voice transceiver and close range transceiver (15, Drawing 1), an earpiece (2, Drawing 2) comprising a bone conduction sensor operatively connected to a second close range transceiver (22, Drawing 2) for communication with the handheld personal communication device (Drawings 1-2; abstract; paragraphs: 0006 – 0010).

Thus, it would have been obvious to one of ordinary skill to modify Mack's system to provide for the following: a video camera operatively connected to the second body such that in closed position the video camera faces the user and in the open position the video camera faces away from the user as this arrangement would facilitate to provide camera arrangement suitable for user applications as taught by Shimamura; handheld communication device having a voice transceiver and close range transceiver, an earpiece comprising a bone conduction sensor operatively connected to a second close range transceiver for communication with the handheld personal communication device as this arrangement would facilitate hands free communication as taught by Futami, thus facilitating user convenience.

Mack differs from claim 6 in that he does not specifically teach: first body and second body of the handheld communication device are removably attached.

However, Futami teaches the following: first body (1, Drawing 1) and second body (2, Drawing 1) of the handheld communication device are removably attached as shown in Drawing 1.

Thus, it would have been obvious to one of ordinary skill to modify Mack's system to provide for the following: first body and second body of the handheld communication device are removably attached as this arrangement would facilitate hands free communication as taught by Futami, thus facilitating user convenience.

10. Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chihara in view of Iijima et al. (JP2001-298516, hereinafter Iijima).

Regarding claim 7, Chihara discloses a method of providing video communication comprising: providing a device comprising a first body (11, fig. 1) having a processor operatively connected to display, a plurality of buttons, a voice transceiver (27, fig. 2), and a first close range transceiver (34, fig. 2) and a second body (12, figs. 1 and 2) having a video imaging device and operatively connected to a second close range transceiver (53, fig. 2), acquiring the video image with video imaging device (12, fig. 1) and transmitting video from the second body (12, fig. 2) to the first body (11, figs. 1-2; col. 7, line 3 – col. 8, line 49).

Chihara differs from claim 7 in that he does not specifically teach: the first body is removable from the second body, removing the first body and second body, and displaying the video image on the display of the first body.

However, Iijima discloses portable radio communication equipment which teaches: the first body is removable from the second body, removing the first body (100, Drawing 1) and second body (400, Drawings 1, 5), and displaying the video image on the display (201, Drawing 1) of the first body (abstract; paragraphs: 30).

Thus, it would have been obvious to one of ordinary skill to modify Chihara's system to provide for the following: the first body is removable from the second body, removing the first body and second body, and displaying the video image on the display of the first body as this arrangement would facilitate storage of communication equipment in main body as taught by Iijima, thus providing compact communication equipment for carrying etc.

Regarding claim 8-11, Chihara further teaches the following: storing a representation of the video image and transmitting video image using the voice transceiver (figs. 1-2; col. 7, line 3 – col. 8, line 49), second body (12, fig. 1) further comprises a microphone operatively connected to the second body close range transceiver, transmitting audio from the second body to the first body (11, fig. 1, col. 10 lines 56-67, col. 11 line 1).

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 12-25, 31-36 are rejected under 35 U.S.C 102(b) as being anticipated by Kawamura et al. (JP08-321863, hereinafter Kawamura).

Regarding claim 12, Kawamura discloses a personal communication device, comprising: a housing comprising a first body (for example 100, Drawing 1) and second body (200, Drawing 1) operatively connected to the first body, the second body having a first side and opposite second side, the first body and second body having an open position, a first closed position (Drawing 3) and a second closed position (Drawing 4), the first side of the second body openly exposed and second side of the second body adjacent to the first body in closed position, the second side of the second body openly exposed and the first side of the second body adjacent the first body in the closed position, a voice transceiver disposed in the housing (paragraphs: 0006 – 0019).

Regarding claims 13-25, Kawamura further teaches the following: first body (100, Drawing 1) is slidably attached to the second body (Drawing 1), first plurality of buttons on the first side of the second body and second plurality of buttons on the second side of the second body (Drawing 1, 3), first body includes a display, third body (300, Drawing 1) operatively connected to the first body (drawing 1), third body is slidably hinged to the first body (Drawing 1), first and third body have an open position (Drawings: 1-2), a first closed position (Drawing 3, and a second closed position (Drawing 4), the third body (300, Drawings: 1-2) has a first side and an opposite second side, and wherein the first side of the third body is openly exposed and the second side of the third body is adjacent the first body in the closed position (Drawing 4), and second side of the third body openly exposed and first side of the third body adjacent to

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the first body in the second closed in the second closed position, first body includes a display (310, Drawing 5), second body includes a display (204, Drawing 2), the first body and second body includes a display (drawings: 2, 5), the first body is removably attached to the second body (Drawings: 1, 3), first body includes at least one video camera (106, Drawings 1-2), the third body (300, Drawing 4) is irremovably attached to the second body (paragraphs: 0006 – 0019).

Regarding claim 31, Kawamura discloses a personal communication device, comprising: a housing (Drawing 1) comprising a first body (for example 200, Drawing 1), a second body (100, Drawing 1), and a third body (300, Drawing 1), the first body (200) operatively connected to the second body (100), third body (300) operatively connected to the second body (100), a voice transceiver disposed within the housing as shown in Drawing 2 (see abstract)

Regarding claims 32-36, Kawamura further teaches the following: first body (200, Drawing 2) is hinged to the second body (100, Drawing 2), comprising at least one display (200, Drawing 2) or a plurality of buttons associated with each of the first body, second body, and third body (Drawings: 1, 12), first body is slidably hinged to the second body, third body is hinged to the third body, third body is hinged to the third body is slidably hinged to the third body (paragraphs: 0012 – 0017).

13. Claims 26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamura in view of Mack.

Kawamura differs from claims 26 and 30 in that although he discloses attaching camera (106, Drawing 1) to one of the body (for example 100, Drawing 1), he does not

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specifically disclose: third body includes one video camera, second body includes at least one video camera etc.

However, Mack discloses camera (7, fig. 1A, col. 4 lines 39-42) attached to one of the bodies and another camera (21, Drawing 3B) attached to another body (col. 6 lines 49-52).

Thus, it would have been obvious to one of ordinary skill to modify Kawamura's system to provide for the following: third body includes one video camera, second body includes at least one video camera as this arrangement would facilitate to provide cameras at different bodies to suite user's application requirements as thought by Mack.

14. Claims 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamura in view of Palermo et al. (US PAT: 5,982,764, hereinafter Palermo).

Kawamura differs from claims 27-29 in that although he discloses first body, second body, and third body as shown in Drawings 1-2; he does not disclose close range transceivers in them.

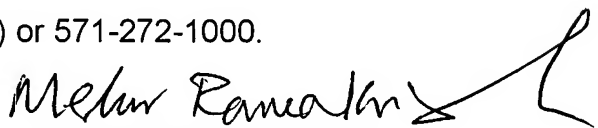
However, Palermo discloses time multiplexed short range magnetic communications which teaches of use close range transceivers in different bodies of communication equipment as shown in figs 2-3 (col. 3, line 66 – col. 4, line 53).

Thus, it would have been obvious to one of ordinary skill to modify Kawamura's system to provide for the following: close range transceivers in first, second and third bodies of communication system as this arrangement would facilitate wireless communications between different communication bodes as taught by Palermo, thus promoting user convenience.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (571)272-8098. The examiner can normally be reached on 9 Hr schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curt Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Melur Ramakrishnaiah
Primary Examiner
Art Unit 2614